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December 8, 1999

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

Attn: Art Unit 3651
Patent Examiner Michael E. Butler

Re:

Application Serial No.:	**09/384,650**
Applicants:	**James A. Michael, et al.**
Title:	**Method For Dispensing Medical Items**
Docket No.:	**D-1079 DIV**

Sir:

Please find enclosed Applicants' Response to the Office Action dated November 22, 1999 for filing in the above case.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Box NON-FEE, Commissioner of Patents and Trademarks, Washington, D.C. 20231 this 13th day of December 1999.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	**James A. Michael, et al.**	)	Art Unit: **3651**
Serial No.:	**09/384,650**	)	Patent Examiner **Michael E. Butler**
Filed:	**August 27, 1999**	)	
For:	**Method For Dispensing Medical Items**	)	

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action dated November 22, 1999 requiring restriction election, Applicants provisionally elect with traverse Group I (claims 40-52).

Reconsideration and withdrawal of said requirement is respectfully requested.

The Definitions of the Groups are improper

Group I

The Action indicates Group I as drawn to "a method of using a dispensing system having a movable, product transport module." However, Group I (claims 40-52) do not recite any "system" or "product transport." These terms are not even found in the Group I claims. Therefore, the restriction requirement is based on an improper Group I definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group II

The Action indicates Group II as drawn to "a method of dispensing with a removable container housing the supply." However, Group II (claims 53-60) do not recite any "removable

container housing" or "supply." These terms are not even found in the Group II claims. Therefore, the restriction requirement is based on an improper Group II definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group III

The Action indicates Group III as drawn to "a method for making a dispensing system for medical products with a slidable container guide." However, Group III (claims 61-62) do not recite any "system", "products", "slidable", or "guide." These terms are not even found in the Group III claims. Therefore, the restriction requirement is based on an improper Group III definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Relationships of the Groups is improper

Groups I and III

Groups I and III were related as "apparatus and product made." The Applicants take exception to the Examiner's assertions. The indicated relationship between Groups I and III is clearly an improper basis for alleging distinct inventions.

Group I is directed to a method. The Examiner also admits that Group I is "drawn to a method." Therefore, it is improper to use Group I as an "apparatus" for restriction purposes.

Group III is directed to a method. The Examiner also admits that Group III is "drawn to a method." Therefore, it is improper to use Group III as a "product made" for restriction purposes.

On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and III

Groups II and III were related as "apparatus and product made." The Applicants take exception to the Examiner's assertions. The indicated relationship between Groups II and III is clearly an improper basis for alleging distinct inventions.

Group II is directed to a method. The Examiner also admits that Group II is "drawn to a

method." Therefore, it is improper to use Group II as an "apparatus" for restriction purposes.

Group III is directed to a method. The Examiner also admits that Group III is "drawn to a method." Therefore, it is improper to use Group III as a "product made" for restriction purposes.

On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and II

Groups I and II were related as "subcombinations disclosed as usable together in a single combination." The Applicants take exception to the Examiner's assertions. The indicated relationship between Groups I and II is clearly an improper basis for alleging distinct inventions. The Action does not indicate as to what "combination" these alleged subcombinations belong. Furthermore, Group II requires the particulars of Group I. Therefore, restriction between Groups I and II is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Groups are not Distinct

Groups I and III

Paragraph 2 of the Action indicates that Groups I and III are distinct because "a different product can be made by the process and the products of inventions I and II may be made via another process."

Applicants disagree. As discussed above, none of the claims are directed to an "apparatus" or "product made." Furthermore, the Action does not state what the alleged "different product" is, nor how the alleged "different product" can be made by the "process", nor what constitutes this alleged "process."

Also, the Action does not state what the alleged "products of inventions I and II" are, nor how these alleged "products" can be made by "another process", nor what constitutes this alleged "another process."

On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and III

Paragraph 2 of the Action indicates that Groups II and III are distinct because "a different product can be made by the process and the products of inventions I and II may be made via another process."

Applicants disagree. As discussed above, none of the claims are directed to an "apparatus" or "product made." Furthermore, the Action does not state what the alleged "different product" is, nor how the alleged "different product" can be made by the "process", nor what constitutes this alleged "process."

Also, the Action does not state what the alleged "products of inventions I and II" are, nor how these alleged "products" can be made by "another process", nor what constitutes this alleged "another process."

On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and II

Paragraph 3 of the Action indicates that Groups I and II are distinct because "invention II has separate utility such as use as a portable medication transport."

Applicants disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination" (MPEP § 806.05(d)). The Action has not shown any "combination." The Action has not shown that the alleged "utility" of Group II is "separate" from that of Group I. The Action has not shown that Group "I" is prevented from having utility as a "portable medication transport." What is in Group I that prevents it from having the same utility as Group II? On the contrary, Group II has the particulars of Group I. Therefore, Group I will always encompass the utility of Group II. Hence, the Action has not shown, as required, that the Groups I and II are separately usable.

Furthermore, the "fact that a claimed device is portable is not sufficient by itself to patentably distinguish." *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952). (MPEP § 2144.04 (V) (A)). Therefore, the Examiner cannot rely on a "portable" utility for showing distinctness.

"If Applicant proves or provides an argument, supported by facts, that the other use,

suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative or withdraw the requirement" (MPEP § 806.05(d)). Applicants, in the reasons presented above, have shown that the other use, suggested by the examiner, is not reasonable. Therefore, on this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action is Unclear

The Examiner's remarks lack any mention of clearly distinguishing the Groups as independent and distinct from each other. The Action leaves Applicants the burden of properly responding to a confusing, contradicting, and improper restriction requirement. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, the Examiner has not given a straightforward and clear restriction requirement based on the laws, regulations, and Office procedures. The Examiner's improper restriction requirement appears to be a failed attempt to puzzle together non fitting restriction pieces. The Examiner has also tried to obfuscate the issue, because there is no proper restriction requirement to be made. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Restriction Requirement is Legally Improper

Applicants additionally respectfully wish to point out that the Action fails to state a legally proper test for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are "distinct." There are no assertions that the sets of claims are "independent", as is required. This standard does not comply with the statutory requirements. Therefore the reasons asserted in the Action for seeking to impose the restriction requirements are legally insufficient due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder.

Furthermore, the Patent Office has acknowledged that before claimed inventions can be considered to be "independent" the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants' methods are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Incorrect Application Serial Number

The Action lists Application Serial Number 09/075,230. However, this listed Serial Number is not correct. The correct Application Serial Number is 09/384,650.

Conclusion

The restriction requirement is respectfully traversed. Groups I and II are not distinct. Groups I and III are not distinct. Groups II and III are not distinct. Therefore, it is respectfully requested that the restriction requirement be withdrawn.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

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